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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,793	08/16/2002	Takeshi Nishio	JP920010176US1	4091
25299	7590	12/30/2005	EXAMINER	
IBM CORPORATION PO BOX 12195 DEPT YXSA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709			DALENCOURT, YVES	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,793

Applicant(s)

NISHIO ET AL.

Examiner

Yves Dalencourt

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to communication filed on 10/10/2005.

Response to Amendment

The examiner has acknowledged the amended claims 1, 3 – 13, 16, and the cancellation of claims 2, 14 – 15, and 17 – 19.

Response to Arguments

Applicant's arguments with respect to claims 1, 3 – 13, and 16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3 – 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey et al (US 2002/0103932; hereinafter Bilbrey) in view of Andre Morkel (US 20020052921; hereinafter Morkel).

Regarding claims 1, 3, 7, 11 – 12 - 13, and 16, Bilbrey teaches an e-mail system, a computer apparatus, and method (1600, fig. 16A), comprising an e-mail transmitter having a recipient list (102, fig. 16A; Bilbrey discloses a sponsor 102) comprising a plurality of recipient addresses (paragraphs [0080], lines 14 – 22; [0081], lines 1 - 9); a terminal (106, fig. 16A) for editing a reference list including one or more recipient addresses to be updated among said plurality of recipient addresses on said recipient address list; and a sponsor database (102, fig. 1) for performing said update of said one or more recipient addresses on said recipient address list by referencing said edited reference list, after said sponsor database obtains said recipient address list and said edited reference list, and for providing said updated recipient address list to said e-mail transmitter, thereby enabling said e-mail transmitter to subsequently use said updated recipient address list for transmitting at least one e-mail message to said recipient address on said updated recipient address list (paragraphs [0082] – [0087]). Claim 12 adds the limitations of a reference list storage ([0095], [0099]), a replacement module ([0057] – [0058]), a deletion module ([0102] and [0108]), and addition module, and a module for providing said recipient address list (paragraphs [0057], [0103] – [0105]).

Bilbrey teaches substantially all the limitations, including the idea that the network server may be configured to update changes in specific mailbox/address identifications and is not tied to updating all the mailboxes/addresses utilized by a specific recipient (see paragraph [0009]), but fails to specifically teach that said updating of one or more recipient addresses is done by the centralized server.

However, Morkel teaches, in the same field of endeavor, systems and methods for managing contact information, which comprises a server database that updates one or more recipient addresses (paragraph [0049]).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Bibrey by updating of one or more recipient addresses by the centralized server as evidenced by Morkel for the purpose of automatically updating contact information, thereby reducing the tasks of adding or deleting recipient(s) addresses by a user in an e-mail system environment.

Regarding claim 4, Bilbrey and Morkel teach all the limitations in claim 1, and Bilbrey further teaches that said reference list contains at least one new recipient address to replace at least one of said plurality of recipient addresses on said recipient address list (paragraphs [0057] – [0058]).

Regarding claim 5, Bilbrey and Morkel teach all the limitations in claim 1, and Bilbrey further teaches that said reference list contains at least one recipient address to be deleted from among said plurality of recipient addresses on said recipient address list (paragraphs [0102] and [0108]).

Regarding claim 6, Bilbrey and Morkel teach all the limitations in claim 1, and Bilbrey further teaches that said reference list contains at least one recipient address to be added to said plurality of recipient addresses on said recipient address list (paragraphs [0057], [0103] – [0105]).

Regarding claim 8, Bilbrey and Morkel teach all the limitations in claim 7, and Bilbrey further teaches that said updating of said first recipient address list is performed on a regular basis (paragraphs [0061], [0062], and [0080]).

Regarding claim 9, Bilbrey and Morkel teach all the limitations in claim 7, and Bilbrey further teaches that said updating of said first recipient address list is performed in response to an indication of generation of said difference list (paragraph [0058]).

Regarding claim 10, Bilbrey and Morkel teach all the limitations in claim 7, and Bilbrey further teaches that said difference list includes at least one of (i) at least one address to be replaced in, (ii) at least one address to be deleted from, and (iii) at least one address to be added to, the plurality of addresses contained in said first recipient address list; and said step of updating said first recipient address list comprises at least one of (i) replacement of the at least one address to be replaced, (ii) deletion of the at least one address to be deleted, and (iii) addition of the at least one address to be added (paragraphs [0102] - [0108]).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

December 26, 2005